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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,226	08/03/2006	Peter Kruger	KRUGER1	6463
1444 7590 12/20/2007 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			EXAMINER PARVINI, PEGAH	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 12/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,226	Applicant(s) KRUGER ET AL.	
	Examiner Pegah Parvini	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12, 14-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 14-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,624,486 to Schmid et al.
3. Regarding claim 11, Schmid et al. teach a luster pigment used in cosmetic preparations based on platelet-like metal substrates, such as such as aluminum, coated with silicon oxide wherein the silicon oxide has a thickness of 50 to 600 nm (Abstract; column 1, lines 3-6, 50-60; column 2, lines 44-50; column 3, lines 31-40). It is noted that the thickness of the silicon oxide as disclosed may be 50 nm; while the thickness is 50 nm, then it would have been obvious to one of ordinary skill in the art that the average particles forming this thickness cannot have an average diameter of greater than 50 nm. Therefore, the reference is assumed to read upon the limitation of claim 11 of the instant application.

With reference to the sol-gel process, it should be noted that this is a process limitation in a product claim; thus, it is not considered to add patentable weight to the

examination of the product claim. It is well settled that if the examiner can find a product in the prior art that is the same or so similar to have been obvious, the burden can be shifted to the applicant to demonstrate that the process for producing the composition somehow imparts a patentable distinction to the composition of the examination.

With reference to the properties instantly claimed in claim 11, the reference, although does not expressly disclose the properties as recited in claim 11, discloses a substantially identical composition, and substantially identical compositions cannot have mutually exclusive properties. Therefore, the claimed properties are assumed to be inherent to the composition of the reference. See MPEP § 2112.01.

4. Regarding claims 14 and 15, even though Schmid et al. do not expressly disclose the properties recited in said claims, the reference discloses a substantially identical composition, and substantially identical compositions cannot have mutually exclusive properties. Therefore, the claimed properties are assumed to be inherent to the composition of the reference. See MPEP § 2112.01.

5. Claims 12, 16-17, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. as applied to claim 11 above, and further in view of US Patent Application Publication No. 2003/0051634 to Takahashi.

6. Regarding claims 12, 16-17, and 21-22, Schmid et al. disclose a pigment composition comprising a metal substrate coated with silicon oxide wherein the composition is used in cosmetic as noted in details above.

Schmid et al., although disclosing the use of said composition in cosmetic, do not expressly disclose or refer to different cosmetic formulations in which said metal substrate coated with silicon oxide composition may be used. Also the reference does not disclose the amount of the metal pigment used in said cosmetic formulations.

Takahashi teaches flaky pigment in which the flaky substrate is preferably a metal pigment coated with a silicon dioxide wherein said combination is used in cosmetic preparation ([0008], [0014], [0017], [0023]). The reference, also, discloses that this is done through sol-gel method ([0026], [0037]). Furthermore, Takahashi discloses the use of said metal substrate coated with silicon dioxide in cosmetic formulations such as lipstick, eye-shadow, nail enamel and more ([0085], [0086]). In addition, the reference discloses that the amount of said pigment in those formulations may be from 1% to 100% depending on the specific formulation used ([0086]).

It should be noted that there is overlapping between the amount of said pigment as disclosed in the reference with the ranges claimed in the instant claims 16, 21, and 22.

Therefore, it would have been obvious to a person of ordinary skill in the art to have utilized the specific cosmetic usages of said pigment and the amount of the pigment in different cosmetic formulations as that taught by Takahashi in Schmid et al. motivated by the fact that Takahashi discloses that disclosed pigment has enhanced

interference colors and di-chromatic effect and is produced in a simple and inexpensive apparatus ([0005]). Thus, it would have been obvious to utilize Takahashi to minimize the cost. Furthermore, the combination of references would have been obvious motivated by the fact that they are from the same field of art of producing pigment composition used in cosmetic, specifically, metal substrate pigment which are coated with oxides, such as silicon oxide.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. in view of Takahashi as applied to claim 17 above, and further in view of US Patent No. 4,897,261 to Yamazaki et al. and in further view of US Patent No. 4,894,224 to Kuwata et al.

8. Regarding claim 18, Schmid et al. in view of Takahashi disclose a pigment used in cosmetic formulations comprising a metal substrate, such as aluminum, coated with oxides, such as silicon oxide, in which the average particle size of the silicon oxides is less than 100nm and the amount of said pigment is within the claimed range as discussed in details above.

The references as combined do not expressly disclose the use of nitrocellulose in said cosmetic formulation or nail enamel.

Yamazaki et al., drawn to finger nail cosmetic composition, specifically disclose the use of nitrocellulose in fingernail cosmetic compositions (column 1, lines 1-21; column 2, lines 62-66; column 3, lines 1-5).

Thus it would have been obvious to modify the Schmid et al. in view of Takahashi in order to utilize nitrocellulose in their cosmetic formulations such as nail enamel motivated by the fact that Yamazaki et al., also drawn to the same field of art of cosmetic formulations and their components, disclose the use of nitrocellulose and specifically indicates that their fingernail cosmetic has a safety factor superior to previous art (column 2, lines 42-47). However, this combination is, also, motivated by the fact that it is well settled in the art that nitrocellulose is one of the conventional additives used in cosmetic formulations as that taught by Kuwata et al.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. in view of Takahashi in view of Yamazaki et al. in view Yamazaki et al. and Kuwata et al. as applied to the claims rejected above and in further view of US Patent No. 5,089,250 to Forestier et al.

10. Regarding claim 19, the combination of references cited above disclose a cosmetic formulation comprising nitrocellulose and a pigment comprising a metal substrate, such as aluminum, coated with oxides, such as silicon oxide, in which the

average particle size of the silicon oxides is less than 100nm and the amount of said pigment is within the claimed range as discussed in details above.

The references as combined to do not expressly disclose the existence of benzotriazoles in said cosmetic preparations although Takahashi disclose the use of UV absorbent in cosmetics ([0091]).

Forestier et al. disclose cosmetic compositions comprising benzotriazole used as a UV filter for the protection of skin and hair.

Thus, it would have been obvious to a person of ordinary skill in the art to have modified the combination of references to expressly disclose the use of benzotriazoles and its derivatives in cosmetics motivated by the fact that Forestier et al. discloses the use of such compounds as UV filtering agents which have good cosmetic and filtering properties over a wide range of wavelengths (column 1, lines 4-10, 33-37, 52-56, 63-67; column 5, lines 5-8; column 6, lines 41-44).

Response to Amendment

11. Applicants' amendment to claim 11 by incorporating the limitations of claims 13 and 20, filed October 9, 2007, page 2, is acknowledged. However, the amendment is not sufficient to overcome the rejection as set forth above. Nevertheless, the in view of the amendments the Non-Statutory Double Patenting Provisional rejection over co-pending application 10/525,395 has been withdrawn.

12. Applicants' amendment to claim 16, filed October 9, 2007, page 3, is acknowledged. However, the amendment is not sufficient to overcome the rejection as set forth above.

13. Applicants' amendment to claim 19, filed October 9, 2007, page 3, is acknowledged. As such, the objection to said claim as set forth in the previous Office Action is withdrawn.

14. Applicants' amendment to the instant application by cancelling claims 13 and 20 is acknowledged. However, this does not place the application in condition for allowance as set forth above.

Response to Arguments

15. Applicant's arguments with respect to claims 11-20 have been considered but are moot in view of the new ground(s) of rejection.

With reference to the Non-Statutory Double Patenting Provisional rejection of claims 11-13 and 17 over claims 1, 3, 4 and 20 of co-pending application 10/525,395, the Applicants have argued that it is premature because there can be no double patenting until the claims of the co-pending application have been patented.

The Examiner, respectfully, disagrees and submits the rejection was proper. See MPEP § 804.

"Occasionally, the examiner becomes aware of two copending applications that were filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee, or that claim an invention resulting from activities undertaken within the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(2) and (3), that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. In *re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); In *re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications."

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,733,364 to Schmid et al.

US Patent Application Publication No. 2003/017479 to Lennon

US Patent Application Publication No. 2006/0280712 to Kuroda et al.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pegah Parvini whose telephone number is 571-272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP


J. A. LORENZO
SUPERVISORY PATENT EXAMINER